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OFFICE OF PETITIONS

In re Application of
Briton, et al.
Application No. 10/722,733
Filed: November 25, 2003
Attorney Docket No. 11767-055-999

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: DECISION ON PETITION
: UNDER 37 CFR 1.182
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This is a decision on the “REQUEST FOR RECONSIDERATION OF DECISION ON PETITION UNDER 37 C.F.R. §1.182”, filed October 31, 2008 , requesting entry of an Application Data Sheet (ADS) to insert a reference to an earlier-filed application pursuant to the provisions of 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the ADS.

The petition is **DISMISSED**.

The above-noted **abandoned** application failed to make a specific reference to the prior-filed application; namely, that it is a continuation-in-part of 09/623,548, filed September 5, 2000, prior to abandonment.¹ In a petition filed June 30, 2008, petitioner requested that the instant abandoned application be amended by inserting a reference to the earlier-filed application. However, the petition was dismissed in a decision mailed on September 2, 2008. The decision acknowledged that 35 U.S.C. § 120 permits entry of a subsequent amendment or ADS to an abandoned application in applications filed prior to November 29, 2000 to include the benefit of an earlier filing date for purposes other than prosecution. See Sampson v. Commissioner of Patents and Trademarks, 195 USPQ 136 (DC DC 1976). However, the decision noted that as the instant application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3) was required.

On renewed petition, petitioner cites the Office’s attention to MPEP 201.11(v), which states that a petition under 37 CFR 1.78(a)(3) is not required where an applicant seeks to change the relationship of the applications. Applicant argues that he merely seeks to amend the instant

¹ The application became abandoned for failure to file a reply to the non-final Office action mailed December 29, 2004.

application to indicate that it is a continuation-in-part, rather than a continuation, of application No. 09/623,548.

Applicant's argument has been considered, but is not persuasive. It is true that if the instant application was in pendency status, then a petition under 37 CFR 1.78 would not be required to change the relationship between the applications. However, the priority claim made on the filing of the present application on November 25, 2003 was incorrect. As set forth in MPEP 201.11(III)(A), the reference must state the proper relationship. On filing, both the specification and the ADS stated that the present application "claims priority to US Application No. 09/623,548". Thus, the change that petitioner is attempting to make is not merely a correction of the relationship. While the USPTO noted the 09/623,548 application on the filing receipt, the incorrect relationship was inserted. While a petition under 37 CFR 1.78 is unnecessary where the USPTO picks up the priority claim, if the USPTO picks up the priority claim and as a result of ambiguity in the claim the incorrect relationship is inserted on the filing receipt, a petition under 37 CFR 1.78 is necessary.

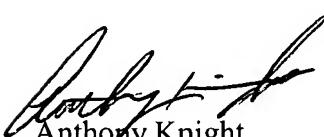
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